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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,673	01/29/2001	Shinichi Takahashi	041514-5106	5427

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EXAMINER

MENEFEE, JAMES A

ART UNIT PAPER NUMBER

2828

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/770,673

Applicant(s)

TAKAHASHI ET AL.

Examiner

James A. Menefee

Art Unit

2828

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.


- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

  
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**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 17.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Amendment*

In response to the amendment filed 9/22/2003, claims 1 and 4 are amended. Claims 1-5 are pending.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2 and 4-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Kasuga (US 6,125,091). Kasuga discloses the claimed invention as follows:

Regarding claim 1, Kasuga discloses a laser diode chip for an optical pickup apparatus in which a plurality of light emitting portions 4,5 are formed on a substrate 3 for emitting laser beams L1,L2, each of said plurality of light emitting portions 4,5 is provided for reading information recorded on a recording medium 25 and the laser beams have different wavelengths so as to correspond to different types of recording medium, where respective light emitting points of said plurality of light emitting portions 4,5 are located in different positions in the emitting direction (see Fig. 1 and the discussion thereof).

Regarding claim 2, the respective light emitting points of said plurality of light emitting portions 4,5 are located in an order in which a short wavelength (650 nm) of each of the laser

Art Unit: 2828

beams (L2) emitted from the light emitting points is forward in the emitting direction as compared to an emitting direction of a longer wavelength (780 nm) beam (L1).

Regarding claim 4, the limitations are disclosed as in the rejection of claim 1 above, and there is further an optical system for guiding the laser beams emitted from the light emitting device to a recording surface of said recording medium and guiding a laser beam reflected by the recording surface to a photosensing device 11.

Regarding claim 5, the limitations are disclosed as in the rejection of claim 2 above.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kasuga in view of Tanaka (previously cited US 5,619,521). Kasuga discloses that the light emitting portions 4,5 are disposed on one surface of a substrate 3, but it is not disclosed that a common electrode is formed on the other surface of the substrate. It is well known that when a number of light emitting devices are formed on a single substrate, that a common electrode may be formed on the opposite side of the substrate. See for example Tanaka. It would have been obvious to one skilled in the art to form a common electrode on the opposing side of the substrate because then both light emitting devices may be powered by running a voltage through a single electrode, thus simplifying the design of the device, as is well known.

***Response to Arguments***

Applicant's arguments filed 9/22/2003 have been fully considered but they are not persuasive.

Applicant argues that “[I]n Kasuga, the base 3 is provided for supporting the optical system of the optical pickup...the base 3 is a portion of the optical pickup apparatus. There is no teaching or suggestion in Kasuga of providing the base 3 as a portion for forming a chip with only the semiconductor lasers 4 and 5...[In] claim 1, the substrate and the plurality of light emitting portions are formed as one body [and] is a portion of the laser diode chip, not a part for constructing an optical system...[T]he base 3 of Kasuga does not correspond to the substrate of claim 1.” (Arguments on pp. 5-6 of response, emphasis in original).

These arguments are not persuasive. Applicant appears to be emphasizing the point that the substrate should not include any elements other than the light emitting portions. However, while such limitations may be required in the specification, the claims do not require this. The claims require, among other things, a laser diode chip comprising a substrate and a plurality of light emitting portions on the substrate. There is nothing in the claims that prevents the substrate from including other elements. By using the term comprising, the chip may include other elements not claimed. Even if the specification limits the substrate from including other elements, this is not claimed. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *See In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Thus, the applicant's arguments are based on limitations drawn from the specification that are not claimed. Kasuga's light emitting portions 4,5 are formed on the substrate 3. It does not matter that additional elements are on the substrate 3. If the applicant wishes to distinguish from Kasuga more structural limitations must be added. Kasuga reads on the limitations as presently claimed, and so the rejection is upheld.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Menefee whose telephone number is (703) 605-4367. The examiner can normally be reached on M-F 8:30-5.

Art Unit: 2828

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Ip can be reached on (703) 308-3098. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



JM

October 23, 2003



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